



08 JUN 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

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HARRINGTON & SMITH, PC  
4 RESEARCH DRIVE  
SHELTON, CT 06484-6212

In re Application of  
TAI, Kenny et al.  
Application No.: 10/560,194  
PCT No.: PCT/SG04/00176  
Int. Filing Date: 10 June 2004  
Priority Date: 11 June 2003  
Attorney's Docket No.: 003D.0083.U1(US)  
For: Receptacle Connector Assembly for IC Card and IC  
Card Connector

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DECISION ON  
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RENEWED PETITION  
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UNDER 37 CFR 1.47(a)  
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This is a decision on applicant's "Petition Under 37 C.F.R. 1.181 To Invoke the Supervisory Authority of the Commissioner," filed in the United States Patent and Trademark Office on 29 January 2007. The petition will be treated as a renewed petition under 37 CFR 1.47(a) to accept the declaration on behalf of non-signing inventor Scott Lu. No petition fee is due.

BACKGROUND

On 10 June 2004, applicants filed international application PCT/SG04/00176, claiming a priority date of 11 June 2003. The thirty-month for paying the basic national fee in the United States expired at midnight on 11 December 2005.

On 08 December 2005, applicants filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, *inter alia*, the requisite basic national fee.

On 15 March 2006, the Office mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) and the surcharge for late filing of the oath or declaration were required.

On 11 April 2006, applicants filed a response to the Notification of Missing Requirements including, a declaration executed by Kenny Tai and Maslow Lin, a petition under 37 CFR 1.47(a) requesting acceptance of the declaration on behalf of the non-signing inventor Scott Lu and, a check for \$330 to cover the required petition fee (\$200) and surcharge for late filing of the oath or declaration (\$130).

On 03 August 2006, the Office mailed the "Decision On Petition Under 37 CFR 1.47(a)," dismissing applicants' petition without prejudice. Although the submitted evidence indicated that a copy of the application had been sent to non-signing inventor Scott Lu, because the receipt of the papers was unconfirmed and only a single mailing had been attempted, the Decision found that the evidence, as a whole, did not support the conclusion that the inventor refuses to execute the declaration in the present application. Further, the Decision indicated that because applicants have not provided firsthand evidence that non-signing inventor Scott Lu has made an express refusal, it cannot be concluded that the inventor has constructively refused to sign the application.

On 25 September 2006, applicants filed a "Renewed Petition Under 37 CFR 1.47(a)" requesting acceptance of the declaration on behalf of the non-signing inventor Scott Lu and providing a copy of a second letter mailed to non-signing inventor Scott Lu showing that a second copy of the application papers were being mailed.

On 12 January 2007, the Office mailed the "Decision On Renewed Petition Under 37 CFR 1.47(a)," dismissing applicants' petition without prejudice. Because applicants did not provide additional evidence of receipt of the application papers by non-signing inventor Scott Lu or any confirmation of the accuracy of address of non-signing inventor Scott Lu, the Decision found that the submitted evidence as a whole did not support the conclusion that the inventor refuses to execute the declaration in the present application.

On 29 January 2007, applicants filed a "Petition Under 37 C.F.R. 1.181 To Invoke the Supervisory Authority of the Commissioner," requesting acceptance of the declaration on behalf of the non-signing inventor Scott Lu and, copies of receipts confirming that the mailings of 07 February 2006 and 08 August 2006 at the last known address of non-signing inventor Scott Lu have been received.

### DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) a statement of the last known address of the missing inventor, (3) an oath or declaration by each applicant on his or her own behalf and on behalf of the non-signing joint inventor and, (4) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort.

As to items (1) and (2), applicants have submitted the correct petition fee of \$200.00 under 37 CFR 1.17(g) and a statement of the last known address of the non-signing inventor.

With regard to item (3), applicants have filed a declaration executed by the other cooperating inventors and containing an unsigned signature block for the non-signing inventor. This declaration complies with 37 CFR 1.497(a)-(b) and is accepted. Hence, item (3) is satisfied.

With regard to item (4), copies of the Federal Express tracking confirmations are sufficient to show that the application papers were mailed to the last known address of non-signing inventor Scott Lu and that they have been received. Further, the fact that the mailings of 07 February 2006 and 08 August 2006 were not returned to the sender is sufficient evidence to show that the last known address of non-signing inventor Scott Lu is the current address. As such, item (4) is satisfied.

### CONCLUSION

Applicants' renewed petition filed under 37 C.F.R. 1.47(a) is **GRANTED**.

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing.

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the non-signing inventor at her last known address of record.

A notice of the filing of the application under 37 CFR 1.47(a) will be published in the Official Gazette.



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For: Receptacle Connector Assembly for IC Card and IC  
Card Connector

Dear Mr. Lu:

You are named as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. 118. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you care to join in the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

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